

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY K. SEARFOSS

Application No. 10/664,806



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on September 13, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

APPEAL BRIEF

Summary Of Claimed Subject Matter

Appellant filed an Appeal Brief dated April 10, 2006, in response to the Non-Final Rejection mailed January 10, 2006. The Appeal Brief is not in compliance

with the new rules of 37 CFR § 41.37(c) effective September 13, 2004. § 37 CFR § 41.37(c) states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

* * *

(c)(1) The brief shall contain the following items...of this section:

(v) ***Summary Of Claimed Subject Matter.*** A concise statement of each ground of rejection presented for review.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief. The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

Section 37 CFR§ 41.37(c) further states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

In addition, on page 4, under the heading "Grounds of Rejection to be Reviewed on Appeal" in the Appeal Brief, the Appellant stated:

- A. Independent claims 1, 12 and 23 were rejected either alone (claim 1) in or combination with a secondary reference (claims 12 and 23) under 102(e) over U.S. Patent No. 6,513,856 to Swanson et al . . .
- B. Claims 1 was also rejection under 103(a) over U.S. Patent No. 4,505,512 to Schmeichel et al. (Appendix C) in view of DE 101 20 442.

In response, an Examiner's Answer was mailed on May 31, 2006. While the Answer notes that "The appellant's statement of the grounds of rejection to be reviewed on appeal is correct" [page 2], the Examiner's Answer and the Non-Final Rejection mailed January 10, 2006, the following § 103 rejection was made:

Claims 1-5, 7-8, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Swansow et al.

Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmeichel et al. (4,505,512) in view of DE '442.

Claims 12-16, 18-19, 22-27, 29-30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson et al. in view of Searfoss (6,206,449).

Claims 12, 17, 23 and 28 are rejected under 35 U.S.C. 103(a) being unpatentable over Swanson et al. in view of Schmeichel et al. (4,505,512).

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson et al. as applied to claim 1 above, and further in view of the well known in prior art.

Claims 20-21 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson et al. as applied to claims 12 and 23, above, respectively, and further in view of the well known prior art.

A clarification of the claims to be applied under the grounds of rejection is required. While Appellant is not required to Appeal each and every ground of rejection or even every claim within a rejection, the Examiner is required to clarify the rejections on Appeal by adding a section "Grounds of rejection not on Appeal".

EXAMINER'S ANSWER

Evidence Relied Upon

The Examiner's Answer mailed May 31, 2006, is defective. The appendix heading "Evidence Relied Upon" (section 8, pg. 2) the Examiner indicates "[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal."

In accordance with MPEP § 1207.02, the "Evidence Relied Upon" (section 8) should include:

(8) Evidence Relied Upon

A listing of evidence relied on (e.g., patents, publications, admitted prior art), and in the case of non-patent references, the relevant page or pages.

Lastly, a review of the Examiner's Answer reveals that it is not in compliance with the appeals conference requirement as set forth in the Manual of Patent Examining Procedure (MPEP) § 1208 (8th ed., rev. 1, Feb. 2003).

According to MPEP § 1208:

The participants of the appeal conference should include (1) the examiner charged with preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as a conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal.

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the type or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the

Application No. 10/664,806

record clear that an appeal conference has been held.

The Examiner's Answer was not signed or initialed by any of the appeals conference participants. Appropriate correction is required as required under MPEP § 1208.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief of April 10, 2006 defective;
- 2) notify applicant to file a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
- 3) consider the paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v); and
- 4) to give a proper explanation of the ground of rejection;
- 5) vacate the Examiner's Answer mailed May 31, 2006, and issued a revised Examiner's Answer having the missing references listed under the Evidence Relied Upon section, heading (8) of the Examiner's Answer;

- 6) taking corrective action regarding the appeal conference, and
- 7) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: *Patrick J. Nolan*
PATRICK J. NOLAN
Deputy Chief Appeals Administrator
(571) 272-9797

PJN/dal

cc: LARSON, NEWMAN, ABEL,
POLANSKY & WHITE, LLP
5914 WEST COURTYARD DRIVE
STE. 200
AUSTIN, TX 78730